

DAVID M. REILLY et. al.  
Serial No.: 10/668,088

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REMARKS

Claims 1-9 remain before the Examiner for reconsideration. Claim 3 is currently amended.

In the office action of August 17, 2004, the Examiner indicated that the oath or declaration is effective. Specifically, the Examiner indicated that:

A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because applicant does not claim priority to the continuation/divisional applications. The oath appears to be from the first filed application.

Applicants respectfully disagree with the Examiner's assertion that the oath is defective in that it does not claim priority to previous continuation and/or divisional patent applications. Indeed, MPEP §602.05(a) provides specifically that:

A continuation or divisional application filed under 37 CFR 1.53(b) (other than a continuation-in-part (CIP)) may be filed with a copy of the oath or declaration from the prior nonprovisional application. See 37 CFR 1.63(d)(1)(iv).

Thus submission of the oath from the first filed application in this case which is a continuation of a division of a continuation of a continuation of a division of the first filed application or parent application was proper. The priority of the prior continuations and divisions is properly set forth in the present patent application.

In the Office Action dated August 17, 2004, the Examiner also required restriction to one of the following asserted inventions 35 U.S.C. Section 121:

Embodiment 1: Figures 2-4;

Embodiment 2: Figures 6-7;

Embodiment 3: Figures 8, 9A, 9B, 10, 11;

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Embodiment 4: Figures 12-13;

Embodiment 5: Figures 14-15;

Embodiment 6: Figures 16, 17A;

Embodiment 7: Figures 18-19.

Specifically, the Examiner asserted that:

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Gregory Bradley on August 3, 2003 a provisional election was made without traverse to prosecute the invention of Embodiments 4 and 5. Affirmation of this election must be made by applicant in replying to this Office action.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Applicants hereby confirm the election of Embodiments 4 and 5 set forth by the Examiner without traverse. Applicants respectfully assert that claims 1 through 9 are readable on the elected species.

Examiner also objected claim 3. Specifically, the Examiner indicated:

Claim 3 is objected to because of the following informalities: It is dependent on claim 51. The claim will be examined as if it depended from claim 1. Appropriate correction is required.

Applicants have amended claim 3 to depend on claim 1.

The Examiner further rejected Claims 1-9 are under the judicially created doctrine of obviousness-type double patenting "as being unpatentable over claims 1-15 of U.S. Patent No. 5,899,885. Specifically, the Examiner asserted that: "Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application encompass the claims of the parent."

The Examiner also rejected Claims 1-9 under the judicially created doctrine of obviousness-type double patenting "as being unpatentable over claims 8-19 of U.S. Patent No. 6,371,938." Specifically, the Examiner asserted that: "Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application encompass the claims of the parent."

Likewise, the Examiner rejected Claims 1-4, and 7-9 under the judicially created doctrine of obviousness-type double patenting "as being unpatentable over claims 1-5 of U.S. Patent No. 5,779,675." Specifically, the Examiner asserted that: "Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application encompass the claims of the parent."

Applicants have submitted herewith three Terminal Disclaimers to Obviate a Double Patenting Rejection of a Prior Patent. The Commissioner for Patent is hereby authorized to charge and the appropriate fees in connection with the Terminal Disclaimer to Deposit Account No. 13-2530. Applicants respectfully assert that the terminal

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disclaimers obviate the Examiner's rejection of the claims under the judicially created doctrine of obviousness-type double patenting.

In the Office Action dated August 17, 2004, the Examiner also rejected Claims 1-4, 8 under 35 U.S.C. 102(b) "as being anticipated by Lindquist, US 3,997,085." Specifically, the Examiner asserted that:

The intended use recited in the preamble is not accorded patentable weight since the body of the claims recites a complete apparatus and does not rely on the preamble. Accordingly, although Lindquist is for dispensing caulk material, it meets all the limitations of the claimed invention. Barrel 12 anticipates the claimed pressure jacket.

Applicants respectfully traverse the Examiner's rejection.

To assert anticipation under Section 102(b) the cases hold that the Examiner:

must show that each element of the claim in issue is found, either expressly described or under principles of inherency, in a single prior art reference, or, that the claimed invention was previously known or embodied in a single prior art device or practice.

Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. Denied, 465 U.S. 1026 (1984); Tyler Refrigeration v. Kysor Industrial Corp., 777 F.2d 687, 689, 227 USPQ 845, 846-47 (Fed. Cir. 1984) (judgment of anticipation reversed). "In deciding the issue of anticipation, the trier of fact must identify the elements of the claims, determine their meaning in the light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." Lindemann, 730 F.2d at 1458, 221 USPQ at 485; Kalman, 713 F.2d at 771, 218 USPQ at 789.

"The test for determining if a reference anticipates a claim of a patent is whether the reference contains within its four corners adequate directions for the practice of the patent claim . . ." Kistler Instrument A.G. v. United States, 628 F.2d 1303, 1311, 203 USPQ 511, 519, aff'd., 211 USPQ 920 (Ct. Cl. 1980). The reference, whether foreign or domestic, patent or otherwise, must be construed strictly for what it "clearly and

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definitely discloses." Application of Boling, 292 F.2d 306, 310-11, 130 USPQ 161, 164 (CCPA 1961); Aluminum Co. of Am. v. Sperry Products, Inc., 285 F.2d 911, 922, 127 USPQ 394, 403 (6th Cir. 1960), cert. denied, 368 U.S. 890 (1961). A patent is **not** anticipated by a reference "unless the latter exhibits the invention in such full, clear and exact terms as to enable any person skilled in the art to practice it without making experiments." 285 F.2d at 922, 127 USPQ at 403.

Applicants respectfully disagree with the Examiner's assertion that "although Lindquist is for dispensing caulking material, it meets all the limitations of the claimed invention." The pressure jacket assembly of the present invention is operably associated with the housing of an injector and is suitable or adapted to substantially enclose a syringe. Barrel 12 of Lindquist (as admitted by the Examiner in connection with the Examiner's discussion of claims 5, 6 and 9, which is quoted below) is designed to be filled with caulking compound. Barrel 12 does not anticipate the pressure jacket of the present invention as asserted by the Examiner. Indeed, barrel 12 of the caulking gun of Lindquist is inoperable to enclose a syringe as claimed in the present invention. For example, in the fluid injection apparatus of the present invention, the pressure jacket encloses the syringe in a manner such that a drive piston of the injector is extendible through a front opening of the housing of the injector to impart motive force to a plunger disposed within the syringe. Barrel 12 of Lindquist is inoperable for this function. Indeed, Applicants respectfully assert that the caulking gun of Lindquist is not analogous art to the fluid injection apparatus of the present invention.

Moreover, presumably the Examiner is asserting that the cradle member 28 of the caulking gun of Lindquist is readable upon the support member of the present invention. However, cradle 28 of Lindquist is attached to a barrel saddle 43 thereof, whereas the support member of the present invention is pivotably coupled to the injector housing at a rear end of the support member.

Claims 5, 6 and 9 are objected to by the Examiner "as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all

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of the limitations of the base claim and any intervening claims, and if the terminal disclaimers set forth above were filed." Specifically, the Examiner indicated asserted that:

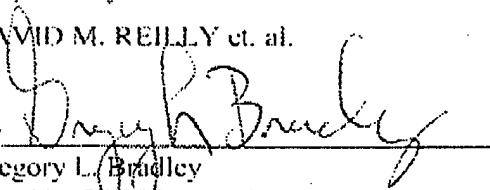
None of the prior art shows or suggests the second front member as claimed in claims 5 and 6, in combination with a pressure jacket that substantially encloses the syringe. In this regard, applicant's comments set forth in parent patent US 5,899,885 are incorporated herein. Regarding claim 9, it is tempting to combine the Sherbondy, US 2,602,571, caulk gun with the Lindquist '085 caulk gun, however, the Lindquist barrel is to be filled with caulking compound (column 4, lines 11-13). It would destroy the operation of the Lindquist reference to attempt to put the slotted holder on the front of the gun. Accordingly, there is no issue of obviousness.

For the reasons set forth above, Applicants respectfully assert that claims 5, 6 and 9 are allowable as written.

In view of the above amendments and remarks, the applicants respectfully requests that the Examiner withdraw the rejections of the claims, indicate the allowability of the claims and arrange for an official Notice of Allowance to be issued in due course.

Respectfully submitted,

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